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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,540	03/23/2004	Jorge L. Orbay	HAN-031	2499

36822 7590 10/18/2006

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EXAMINER	
SHAFFER, RICHARD R	

ART UNIT	PAPER NUMBER
3733	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/806,540	**Applicant(s)** ORBAY ET AL.	
	Examiner Richard R. Shaffer	**Art Unit** 3733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
 a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☒ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

 NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: *1-24 and 27-29*.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER

Richard Shaffer
10/12/06

Continuation of 3. NOTE: Claims 1,11 and 19 still contain new matter. Merely because applicant discloses a range of possible dimensions capable of calculating a ratio of 5.11 (applicant's 5 is calculated by rounding) does not support approximately 5 times. Further, even if it did support a calculation of exactly 5, it would not account for 'approximately' which could include less. Applicant has no support for taking values less than 5.11 nor has any support for omitting the values between 5.11 and 6 for ratio comparisons. Further, additional limitations have been added to the independent claims such as frictional engagement changing the scope of the claims and thereby requiring additional consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because: In regard to claims 1-24 and 29, applicant merely argues all points previously explained in the previous Office Action. The interpretation given to the limitation "orthopedic nail" can reasonably be interpreted as being the potion 12d in Finlayson. It is metal, it is elongated, and it is inherently capable of orthopedic applications. In addition to those listed prior, the device can be passed through the vessels to the bone marrow and it can be used as a guide for inserting screws into the bone. In regard to flexibility, the claim does not require "stiff" in relation to supporting bone. The interpreation of the lead-in portion being spaced apart from the end of the nail is completely reasonable. Clearly, the end of the nail is not where the "lead-in" portion is located. Applicants arguments to the passivated end are also still not persuasive, with applicant being directed to the previous Office Action responses to it. It does not matter that applicant uses one defintion for passivated and the examiner uses another as long the examiner's is a reasonable interpretation. In the specification, passivated was referring to covering the "cut end" of a nail. Well, clearly Finlayson's cap covers the end of a what could be interpreted as a nail. So the nail of Finlayson is "passivated" by the cap. Since the end result is a passive end of a nail, it matters not whether the nail itself was passive or non-passive chemically. And as explained previously, the cap passivates the nail physically in order to prevent bodily harm.